

REMARKS

This paper is in response to the Office Action of April 7, 2004. The due date for response extends to July 7, 2004.

A Notice of Appeal is submitted along with this response, as the Applicant believes the claims are in condition for allowance.

A telephone conference with the Examiner was had on July 7, 2004. The discussion was with regard to the application of a new reference, and the Applicant's desire to have previously presented arguments addressed. As noted in the Telephone conference, the Applicant presented a detailed illustration of *why* the teachings of Russo, Garfinkle and Custer do not render the claimed invention obvious. The teachings of these main references are conflicting with what is claimed, and thus, motivation to combine these references is lacking. The simple addition of a new reference, namely Peterson Jr. (5,857,020), does not cure the differences of Russo, Garfinkle and Custer. Although the addition of a new reference does present a new ground of rejection, and the Office Action can be made final due to the Applicant's amendments, the arguments presented on January 16, 2004 are *not* rendered moot. The Examiner indicated that he would revisit the claims, in an effort to assist the Applicant. That Applicant thanks the Examiner for his efforts in this regard.

Claims 1, 9, 17, and 22 were rejected under 35 USC § 112, second paragraph. The Examiner indicates "indefiniteness" regarding the claimed term "a specific content." The Examiner is kindly referred to the detailed description of the as-filed instant application. In one example, the Examiner may refer to page 18, lines 5-11, where the specific content is defined as the specific content among multiple contents of the contents data base. Thus, the use of the term "specific content" is not indefinite, and one of ordinary skill in the art will readily understand the simple and plain meaning of the term, which is defined in the application as-filed, as well as in the claims. Further, the Examiner is reminded that the Applicant provided further explanation of this term in response to the last office action. The Examiner is thus kindly requested to review the as-filed application, the claims as currently presented, and the last office action response. In view of the foregoing, the Applicant respectfully requests the Examiner withdraw this Section 112 rejection.

Claims 1-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,619,247 to James Russo (Russo) in view of U.S. Patent No. 5,530,754 to Norton Garfinkle (Garfinkle), in view of U.S. Patent No. 5,857,020 to Mendel Lazear Peterson Jr., and in view of 5,063,547 to Pieter H. Custer (Custer). In view of the remarks presented herein and presented in the last response, the Applicant traverses and respectfully requests reconsideration of the rejection.

As noted above, the Examiner has presented a new rejection. The new rejection differs from the prior rejection, in that Peterson Jr. was further applied in combination with the previously presented references of Russo, Garfinkle, and Custer.

For clarify, the Examiner is kindly requested to respond to the Applicant's remarks, as the addition of a reference *does not render the remarks moot*. It is also noted that the Examiner has simply reproduced the rejections of past actions, while simply attaching citations to Peterson Jr. in each paragraph. The Applicant's understand that the citations are necessary so that Peterson Jr. can be understood in relation to the rejection, however, Peterson Jr. fails to combine with the existing art.

Peterson Jr. is concerned with the making of particular media available to users at a specific time. The specific time is set in advance, and that time is referred to as the "premier" time. Before the premier time, customers can register to get access to the media. At later times, the customers can view the same media on a "pay-per-use" schedule. As is evident from the narrow teachings of Peterson Jr., the only way a user can gain access to the media is to wait for some premier date and time. This is contrary to the teachings of the present invention and as outlined in the claims. There is simply no premier date/time limitation associated with the functionality defined by the claims. Consequently, Peterson Jr. does not add to the motivation, nor does Peterson Jr. overcome the deficiencies of Russo, Garfinkle, and Custer.

As is well know, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one having ordinary skill in the art, to modify the reference. Additionally, there must be a reasonable expectation of success, and the reference when modified must teach or suggest all


of the claim features. Modifications to prior art that are within the skill of one of ordinary skill in the art at the time of invention is insufficient to establish a *prima facie* case of obviousness without some objective reason to modify. No reasons for the "motivation to combine" were given in the Office Action, as simple citations were used to present the new art and the existing art.

Further, the mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggest the desirability of the combination. (See MPEP §2143.) That is, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. Applicants respectfully submit a *prima facie* case of obviousness is not supported against the claims as proposed to be amended herein.

The remarks previously made by the Applicant regarding the non-combinability of the cited references is herein incorporated by reference. A Notice of Allowance is therefore respectfully requested.

If the Examiner has any questions concerning the present amendment, the Examiner is kindly requested to contact the undersigned at (408) 749-6903. If any other fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. SONYP002). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,
MARTINE & PENILLA, LLP



Albert S. Penilla, Esq.
Reg. No. 39,487

710 Lakeway Drive, Suite 170
Sunnyvale, CA 94085
Telephone: (408) 749-6900
Facsimile: (408) 749-6901
Customer No. 25920